In Re Application of: Shell Simpson, *et al.*)	Confirmation No.: 6072
)	
Serial No.: 10/053,174)	Group Art Unit: 2622
)	
Filed: November 13, 2001)	Examiner: Garcia, Gabriel I.
)	
For: Methods and Systems)	Atty. Docket No.: 10008135-1
for Making Booklets)	

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed September 19, 2007, responding to the Final Office Action mailed June 28, 2007.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

I. **Real Party in Interest**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. **Related Appeals and Interferences**

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. **Status of Claims**

Claims 1, 3-8, and 10-28 stand finally rejected. Claims 2 and 9 have been canceled. No claims have been allowed. The final rejections of claims 1, 3-8, and 10-28 are appealed.

IV. **Status of Amendments**

This application was originally filed on November 13, 2001, with twenty-seven (27) claims. In a Response filed September 2, 2005, Applicant amended claims 1, 10, 14, 18, 23, and 25; canceled claim 9; and added claim 28. In a Response filed February 1, 2006, Applicant presented remarks without any claim amendments. On June 5, 2006, an appeal brief was filed. After reopening of prosecution, in a Response

filed November 16, 2006, Applicant amended claims 1, 3, 4, and 5 and canceled claim 2. The claims in the attached Claims Appendix reflect the present state of Applicant's claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments according to independent claim 1 describe a method comprising receiving (FIG. 1, arrow between item 108 and item 106), via at least one network service (FIG. 2, 166), imaging data that is to be included in a booklet. The method further comprises prior to receiving the imaging data, causing, via at least one network service (FIG. 2, 166), a user interface (FIG. 4, 246) to be presented on a client device (FIG. 3, 202). Applicant's specification, page 11, lines 13-15. The user interface (FIG. 4, 246) is configured to enable a user to select imaging data for use in making a booklet. The receiving imaging data process comprises receiving user selection of the imaging data. Applicant's specification, page 12, lines 22-24. The method further comprises receiving (FIG. 9, 906), via the at least one network service (FIG. 2, 166), user input for incorporating the imaging data into the booklet and building (FIG. 9, 908), via the at least one network service (FIG. 2, 166), a booklet incorporating imaging data in accordance with the user input. Applicant's specification, page 12, lines 19-25. The

method further comprises printing (FIG. 9, 910) the booklet on a network-accessible printer designated by user input. Applicant's specification, pages 19-20, lines 13-6.

Embodiments according to independent claim 10 describe one or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors (FIG. 10, 1002), cause the processors (FIG. 10, 1002) to send content to a client device (FIG. 3, 202) for execution by a client browser (FIG. 3, 204), the content enabling the client device (FIG. 3, 202) to display a user interface (FIG. 4, 240) that is configured to enable a user to select imaging data for use in building a booklet. Page 11, lines 13-15. The content is further enabled to provide, over a network (FIG. 2, 158), a user selection of imaging data for use in building the booklet, page 11, lines 18-19, and provide, over the network (FIG. 2, 158), user input for incorporating the imaging data into the booklet. Page 12, lines 23-24. The content is further enabled to provide, over the network (FIG. 2, 158), user input for designating a network location for printing the booklet. Page 19, lines 23-25. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, page 19, lines 23-35, and pages 23-25, lines 20-14.

. Embodiments according to independent claim 14 describe a method comprising causing, via at least one Web service (FIG. 3, 220), a user interface to be presented on a client device, the user interface (FIG. 4, 240) being configured to enable a user to select imaging data for use in making a booklet. Page 7, lines 18-25 and page 11, lines 1-10. The method further comprises receiving (FIG. 9, 906), via the at least one Web service (FIG, 3, 220), a user selection of imaging data and receiving, page 11, lines 13-15, via the at least one Web service (FIG. 3, 220), user input for incorporating the

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imaging data into a booklet. The method further comprises building (FIG. 9, 908), via the at least one Web service (FIG. 3, 220), a booklet incorporating imaging data received from the user input and printing (FIG. 9, 910), via the at least one Web service (FIG. 3, 220), the booklet on a Web-accessible printer (FIG. 3, 224) designated by the user. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, and page 19, lines 23-35.

Embodiments according to independent claim 18 describe a method comprising receiving, page 11, lines 13-15, via at least one Web service (FIG. 3, 220), a user selection of imaging data that is to be used to build a booklet. The method further comprises receiving (FIG. 9, 906), via the at least one Web service (FIG. 3, 220), user input for incorporating the imaging data into the booklet and receiving, via the at least one Web service (FIG. 3, 220), user input for designating a network device (FIG. 3, 224) for printing the booklet. Page 19, lines 23-25. The method further comprises building (FIG. 9, 908), via the at least one Web service (FIG. 3, 220), a booklet incorporating imaging data received from the user input. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, and page 19, lines 23-35.

Embodiments according to independent claim 22 describe one or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors (FIG. 10, 1002), cause the processors (FIG. 10, 1002) to receive, page 11, lines 13-15, via at least one Web service (FIG. 3, 220), a user selection of imaging data that is to be used to build a booklet. The processors are further caused to receive (FIG. 9, 906), via the at least one Web service (FIG. 3, 220), user input for incorporating the imaging data into the booklet and receive, page 19, lines

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23-25, via the at least one Web service (FIG. 3, 220), user input for designating a network device (FIG. 3, 224) for printing the booklet. The processors are further caused to build (FIG. 9, 908), via the at least one Web service (FIG. 3, 220) a booklet incorporating imaging data received from the user input. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, page 19, lines 23-35; and pages 23-25, lines 20-14.

Embodiments according to independent claim 23 describe a booklet-making method comprising browsing (FIG. 9, 904) to a Web-accessible booklet-making service (FIG. 3, 220). The method further comprises specifying to the Web-accessible booklet-making service (FIG. 3, 220) imaging data that is to be used to make a booklet and how that imaging data is to be used. (FIG. 9, 906; page 11, lines 18-19; and page 12, lines 23-24). The method further comprises constructing (FIG. 9, 908), via the Web-accessible booklet-making service (FIG. 3, 220), a booklet incorporating the imaging data and forwarding, page 10, lines 18-21, from the Web-accessible booklet-making service (FIG. 3, 220), the booklet to a network printer (FIG. 3, 224) designated by a user.

Embodiments according to independent claim 25 describe a web service comprising means (FIG. 5, 266), operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet. The web service further comprises means, operably (FIG. 6, 278) associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where the one or more pages will reside in the booklet and means (FIG. 4, 240), operably associated with the Web, for enabling the user to designate a network printer

for printing the booklet. The web service further comprises means (FIG. 10, 1000), operably associated with the Web, for building the booklet. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, page 19, lines 23-35, and pages 23-25, lines 20-14.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejections are to be reviewed on appeal:

Claims 1, 3-8, and 10-28 stand rejected under 35 U.S.C. § 102(a) as allegedly being unpatentable by *Tonkin* (WO 01/031465).

VII. Arguments

Claims 1, 3-8, and 10-28 have been rejected under 35 U.S.C. § 102(a) as being anticipated by *Tonkin* (WO 01/031465). It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(a).

The Appellant respectfully submits that Applicant's claims 1, 3-8, and 10-28 are patentable under 35 U.S.C. § 102. The Appellant respectfully requests that the Board of Patent Appeals overturn the final rejection of those claims at least for the reasons discussed below.

A.   The *Tonkin* Disclosure

Tonkin describes a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5.   It is noted that *Tonkin* does not disclose that a document production hub 60 causes a user interface to be presented which allows a user to select imaging data for use in making a booklet (where the imaging data was received by the document production hub 60).   Rather, *Tonkin* seemingly describes that document composition and selection of content takes place before a file is uploaded and then afterwards, assembly options are provided.

B.   Applicant's Claims

Tonkin fails to teach several of Applicant's claim limitations.   Applicant discusses some of those claim limitations in the following.

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1. Claim 1

Applicant's independent claim 1 provides as follows (emphasis added):

> A method comprising:
> receiving, via at least one network service, imaging data that is to be included in a booklet;
> ***prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data;***
> receiving, via said at least one network service, user input for incorporating the imaging data into the booklet;
> building, via said at least one network service, a booklet incorporating imaging data in accordance with said user input; and
> ***printing the booklet on a network-accessible printer designated by user input.***

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least "prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data" and "printing the booklet on a network-accessible printer designated by user input," as emphasized above.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify

document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest "prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data," as recited in claim 1. For example, the Office Action mailed August 16, 2006 construes a network service to be a document production hub 60 in *Tonkin* but *Tonkin* does not disclose that a document production hub 60 causes a user interface to be presented which allows a user to select imaging data for use in making a booklet (where the imaging data was received by the document production hub 60). Rather, *Tonkin* seemingly describes that document composition and selection of content takes place before a file is uploaded and then afterwards, assembly options are provided.

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the

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production facility. *See* page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "printing the booklet on a network-accessible printer designated by user input," as recited in claim 1.

In the Final Office Action of June 28, 2007, the Examiner "asserts that Tonkin teaches designate a network accessible printer (see fig. 5, item 302, which depicts the different network printer within kinko's (such as Lexmark 1650, which clearly is not a virtual printer)." Page 11 (emphasis removed). In response, Applicant points out that *Tonkin* clearly states that "each displayed 'printer' actually is registered virtual printer in the printer folder." The list of printers is obtained from Windows registry and correspond to printers installed on the user's computer and are not printers located in a Kinko's facility, as suggested by the Examiner. Further, *Tonkin* clearly states that "[i]ncluded with the virtual printers (which correspond to attached physical printers) is a virtual printer 306 according to the present invention. Clicking on virtual printer 306 selects that printer." The designation for virtual printer 306 is "Print to Kinko's." *See* FIG. 5 and page 19, lines 7-13. Accordingly, *Tonkin* does not disclose that a network-accessible printer is designated by a user.

As such, *Tonkin* does not anticipate claim 1, and the rejection of claim 1 should be overturned.

    2.   Claims 3-8 and 28

Dependent claims 3-8 and 28 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features of allowable independent claim

1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). For at least this reason, the rejections of claims 3-8 and 28 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 3-8 and 28, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

3.   Claim 10

Applicant's independent claim 10 provides as follows (emphasis added):

> One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:
> ***send content to a client device for execution by a client browser, said content enabling the client device to:***
> ***display a user interface that is configured to enable a user to select imaging data for use in building a booklet;***
> provide, over a network, a user selection of imaging data for use in building the booklet;
> provide, over the network, user input for incorporating the imaging data into the booklet; and
> ***provide, over the network, user input for designating a network location for printing the booklet.***

Applicant respectfully submits that independent claim 10 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature to "send content to a client device for execution by a client browser, said content enabling the client device to: display a user interface that is configured to enable a user to select imaging data for use in building a booklet" or "provide, over the network, user input for designating a network location for printing the booklet," as emphasized above.

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Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest to "send content to a client device for execution by a client browser, said content enabling the client device to: display a user interface that is configured to enable a user to select imaging data for use in building a booklet," as recited in claim 10. For example, *Tonkin* does not disclose that a document production hub 60 or other device enables a client device to display a user interface that is configured to enable a user to select imaging data for use in building a booklet.

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual

printer only specifies a production facility and not a particular network printer within the production facility. *See* page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest to "provide, over the network, user input for designating a network location for printing the booklet," as recited in claim 10.

Accordingly, *Tonkin* does not anticipate claim 10, and the rejection of claim 10 should be overturned.

4.   Claims 11-13

Dependent claims 11-13 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features of allowable independent claim 10. For at least this reason, the rejections of claims 11-13 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 11-13, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

5.   Claim 14

Applicant's independent claim 14 provides as follows (emphasis added):

> A method comprising:
> ***causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet;***
> receiving, via said at least one Web service, a user selection of imaging data;
> receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet;
> building, via said at least one Web service, a booklet incorporating imaging data received from said user input; and

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printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user.

Applicant respectfully submits that independent claim 14 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least "causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet" and "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user," as emphasized above.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest "causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet," as recited in claim 14. For example,

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the Office Action of August 16, 2006 construes a Web service to be a document production hub 60 in *Tonkin* but *Tonkin* does not disclose that a document production hub 60 causes a user interface to be presented which allows a user to select imaging data for use in making a booklet (where the imaging data was received by the document production hub 60).

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. *See* page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user," as recited in claim 14.

In the Final Office Action of June 28, 2007, the Examiner "asserts that Tonkin teaches designate a network accessible printer (see fig. 5, item 302, which depicts the different network printer within kinko's (such as Lexmark 1650, which clearly is not a virtual printer)." Page 11 (emphasis removed). In response, Applicant points out that *Tonkin* clearly states that "each displayed 'printer' actually is registered virtual printer in the printer folder." The list of printers is obtained from Windows registry and correspond to printers installed on the user's computer and are not printers located in a Kinko's facility, as suggested by the Examiner. Further, *Tonkin* clearly states that "[i]ncluded with the virtual printers (which correspond to attached physical printers) is a virtual printer 306 according to the present invention. Clicking on virtual printer 306 selects

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that printer." The designation for virtual printer 306 is "Print to Kinko's." *See* FIG. 5 and page 19, lines 7-13. Accordingly, *Tonkin* does not disclose that a Web-accessible printer is designated by a user.

Accordingly, *Tonkin* does not anticipate claim 14, and the rejection of claim 14 should be withdrawn.

6. Claims 15-17

Dependent claims 15-17 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features and steps of allowable independent claim 14. For at least this reason, the rejections of claims 15-17 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 15-17, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

7. Claim 18

Applicant's independent claim 18 provides as follows (emphasis added):

> A method comprising:
> receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;
> ***receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet;***
> receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and
> building, via said at least one Web service, a booklet incorporating imaging data received from said user input.

Applicant respectfully submits that independent claim 18 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of

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"receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet," as recited and emphasized above in claim 18.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest "receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet," as recited in claim 18. For example, the Office Action of August 16, 2006 construes a Web service to be a document production hub 60 in *Tonkin* but *Tonkin* does not disclose that a document production hub 60 receives user input for incorporating imaging data into a booklet.

Accordingly, *Tonkin* does not anticipate claim 18, and the rejection of claim 18 should be overturned.

8. Claims 19-21

Dependent claims 19-21 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features and steps of allowable independent claim 18. For at least this reason, the rejections of claims 19-21 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 19-21, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

9. Claim 22

Applicant's independent claim 22 provides as follows (emphasis added):

> One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:
> receive, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;
> ***receive, via said at least one Web service, user input for incorporating the imaging data into the booklet;***
> receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and
> build, via said at least one Web service, a booklet incorporating imaging data received from said user input.

Applicant respectfully submits that independent claim 22 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least to "receive, via said at least one Web service, user input for incorporating the imaging data into the booklet," as emphasized above.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is

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opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest to "receive, via said at least one Web service, user input for incorporating the imaging data into the booklet," as recited in claim 22. For example, the Office Action of August 16, 2006 construes a Web service to be a document production hub 60 in *Tonkin* but *Tonkin* does not disclose that a document production hub 60 receives user input for incorporating imaging data into a booklet.

Accordingly, *Tonkin* does not anticipate claim 22, and the rejection of claim 22 should be overturned.

10. Claim 23

Applicant's independent claim 23 provides as follows (emphasis added):

> A booklet-making method comprising:
> **browsing to a Web-accessible booklet-making service;**
> **specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used;**
> constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data; and

***forwarding, from said Web-accessible booklet-making service,
the booklet to a network printer designated by a user.***

Applicant respectfully submits that independent claim 23 is allowable for at least

the reason that *Tonkin* does not disclose, teach, or suggest at least "browsing to a Web-

accessible booklet-making service," "specifying to said Web-accessible booklet-making

service imaging data that is to be used to make a booklet and how that imaging data is

to be used," or "forwarding, from said Web-accessible booklet-making service, the

booklet to a network printer designated by a user," as recited and emphasized above in

claim 23.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the

printer driver: a preview of the document is displayed; the document is uploaded to the

document production hub upon request from the user; and then a communication link is

opened with the document production hub." Page 12, lines 25-30. Therefore, the

document is previewed before the document is ever uploaded to the document

production hub in *Tonkin*. After the document is uploaded, the user can specify

document assembly instructions and then preview the document as so assembled.

Page 15, lines 24-26. "The specified assembly instructions might include for example:

type and color of the paper or other media (e.g., transparencies) to be used for printing

the uploaded document; type, size and color of the binding or clips to be used; type and

color of the front cover and back cover; type and position of any tab pages, together

with a specification of any content to be printed on each tab page; and the number of

copies of the assembled document to be created." Pages 15-16, lines 30-5. As such,

Tonkin fails to teach or suggest "browsing to a Web-accessible booklet-making service"

and "specifying to said Web-accessible booklet-making service imaging data that is to

be used to make a booklet and how that imaging data is to be used," since in *Tonkin*, a document is uploaded to a document production hub in response to selection of a print driver and not browsing to a Web-accessible booklet-making service.

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. *See* page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user," as recited in claim 23.

In the Final Office Action of June 28, 2007, the Examiner "asserts that Tonkin teaches designate a network accessible printer (see fig. 5, item 302, which depicts the different network printer within kinko's (such as Lexmark 1650, which clearly is not a virtual printer)." Page 11 (emphasis removed). In response, Applicant points out that *Tonkin* clearly states that "each displayed 'printer' actually is registered virtual printer in the printer folder." The list of printers is obtained from Windows registry and correspond to printers installed on the user's computer and are not printers located in a Kinko's facility, as suggested by the Examiner. Further, *Tonkin* clearly states that "[i]ncluded with the virtual printers (which correspond to attached physical printers) is a virtual printer 306 according to the present invention. Clicking on virtual printer 306 selects that printer." The designation for virtual printer 306 is "Print to Kinko's." *See* FIG. 5 and

page 19, lines 7-13. Accordingly, *Tonkin* does not disclose that a network printer is designated by a user.

Accordingly, *Tonkin* does not anticipate claim 23, and the rejection of claim 23 should be overturned.

11. Claim 24

Because independent claim 23 is allowable over the cited art of record, dependent claim 24 is allowable as a matter of law, for at least the reason that the dependent claim contains all the features and steps of independent claim 23. For at least this reason, the rejection of claim 24 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claim 24, this claim recites further features and/or combinations of features (as are apparent by examination of the claim itself) that are patentably distinct from the cited art of record. Hence, there are other reasons why this claim is allowable.

12. Claim 25

Applicant's independent claim 25 provides as follows (emphasis added):

> A web service comprising:
> means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet;
> means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet;
> **means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet;** and
> means, operably associated with the Web, for building the booklet.

Applicant respectfully submits that independent claim 25 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least "means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet," as recited and emphasized above in claim 25.

Rather, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. *See* page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet," as recited in claim 25.

In the Final Office Action of June 28, 2007, the Examiner "asserts that Tonkin teaches designate a network accessible printer (see fig. 5, item 302, which depicts the different network printer within kinko's (such as Lexmark 1650, which clearly is not a virtual printer)." Page 11 (emphasis removed). In response, Applicant points out that *Tonkin* clearly states that "each displayed 'printer' actually is registered virtual printer in the printer folder." The list of printers is obtained from Windows registry and correspond to printers installed on the user's computer and are not printers located in a Kinko's facility, as suggested by the Examiner. Further, *Tonkin* clearly states that "[i]ncluded with the virtual printers (which correspond to attached physical printers) is a virtual printer 306 according to the present invention. Clicking on virtual printer 306 selects that printer." The designation for virtual printer 306 is "Print to Kinko's." *See* FIG. 5 and

page 19, lines 7-13. Accordingly, *Tonkin* does not disclose that a network printer is designated by a user.

Accordingly, *Tonkin* does not anticipate claim 25, and the rejection of claim 25 should be withdrawn.

13.   Claims 26-27

Dependent claims 26-27 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features of allowable independent claim 25. For at least this reason, the rejections of claims 26-27 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 26-27, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.
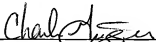
C.   Summary

Due to the shortcomings of the *Tonkin* reference described in the foregoing, Applicant respectfully asserts that *Tonkin* does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be overturned.

VIII. <u>Conclusion</u>

In summary, it is Applicant's position that Applicant's claims are patentable over the applied cited art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A method comprising:

receiving, via at least one network service, imaging data that is to be included in a booklet;

prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data;

receiving, via said at least one network service, user input for incorporating the imaging data into the booklet;

building, via said at least one network service, a booklet incorporating imaging data in accordance with said user input; and

printing the booklet on a network-accessible printer designated by user input.

2. Canceled

3. The method of claim 1, wherein said receiving user selection comprises receiving user selection of multiple documents for use in building said booklet.

4. The method of claim 1, wherein said receiving user selection comprises receiving user selection of multiple documents for use in building said booklet, said multiple documents being retrievable from a user-associated, network-accessible personal imaging repository and further comprising prior to said building, retrieving, via said at least one network service, said multiple documents from the personal imaging repository.

5. The method of claim 1, wherein said acts of causing, receiving user selection, and receiving user input are respectively performed by multiple network services.

6. The method of claim 1, wherein said at least one network service is implemented, at least in part, by at least one printer.

7. The method of claim 1, wherein said at least one network service is implemented, at least in part, by at least one proxy server that serves as a proxy for at least one printer.

8. The method of claim 1 further comprising saving the booklet, via said at least one network service, in a personal imaging repository associated with the user.

9. Canceled

10. One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

send content to a client device for execution by a client browser, said content enabling the client device to:

display a user interface that is configured to enable a user to select imaging data for use in building a booklet;

provide, over a network, a user selection of imaging data for use in building the booklet;

provide, over the network, user input for incorporating the imaging data into the booklet; and

provide, over the network, user input for designating a network location for printing the booklet.

11. One or more computer-readable media as recited in claim 10, wherein the instructions further cause the one or more processors to save, via the network, a booklet that has been built based on the user's input.

12. One or more computer-readable media as recited in claim 10, wherein the instructions further cause the one or more processors to print, via the network, the booklet on one or more network accessible printers.

13. One or more computer-readable media as recited in claim 10, wherein the instructions further cause the one or more processors to provide said user selection and said user input over a network comprising the Internet.

14. A method comprising:

causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet;

receiving, via said at least one Web service, a user selection of imaging data;

receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet;

building, via said at least one Web service, a booklet incorporating imaging data received from said user input; and

printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user.

15. The method of claim 14 further comprising saving the booklet, via said at least one Web service, in a Web-accessible location.

16. The method of claim 14 wherein said at least one Web service is implemented, at least in part, by at least one printer.

17. The method of claim 14 wherein said at least one network service is implemented, at least in part, by at least one proxy server that serves as a proxy for at least one printer.

18. A method comprising:

receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet;

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and

building, via said at least one Web service, a booklet incorporating imaging data received from said user input.

19. The method of claim 18 further comprising providing the user, via said at least one Web service, options to print the booklet on at least one Web-accessible printer and saving the booklet in a Web-accessible location.

20. The method of claim 18, wherein said at least one Web service is implemented, at least in part, by a Web-accessible printer.

21. The method of claim 18, wherein said at least one Web service is implemented, at least in part, by at least one proxy server that serves as a proxy for at least one printer.

22. One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

receive, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

receive, via said at least one Web service, user input for incorporating the imaging data into the booklet;

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and

build, via said at least one Web service, a booklet incorporating imaging data received from said user input.

23. A booklet-making method comprising:

browsing to a Web-accessible booklet-making service;

specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used;

constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data; and

forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user.

24. The method of claim 23 further comprising printing the booklet via the Web-accessible booklet-making service.

25. A web service comprising:

means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet;

means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet;

means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet; and

means, operably associated with the Web, for building the booklet.

26. The web service of claim 25 further comprising means for printing the booklet.

27. The web service of claim 25 further comprising means for saving the booklet in a personal imaging repository associated with the user.

28. The method of claim 1 further comprising prompting a user to choose a network-accessible printer for printing the booklet from a plurality of available network-accessible printers.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.